



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/765,511	01/19/2001	Daniel R. Kiselik	A-99.59.1	9510

7590 06/03/2005
Arthur Jacob
25 East Salem Street
P.O. Box 686
Hackensack, NJ 07602

EXAMINER

PASS, NATALIE

ART UNIT	PAPER NUMBER
----------	--------------

3626

DATE MAILED: 06/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/765,511

Applicant(s)

KISELIK, DANIEL R.

Examiner

Natalie A. Pass

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 Jan.2001, 19 Nov.2002, 15 Mar.2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 15-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 19/1/01, 19/11/02.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Notice to Applicant

1. This communication is in response to the application filed 19 January 2001, the Preliminary Amendment filed 19 November 2002, and the Response to Restriction Requirement filed 15 March 2005. Claims 1-14 have been elected with traverse. Claims 15-34 are withdrawn from further consideration by the Examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention. Claims 1-14 are pending. The Information Disclosure Statements filed 19 January 2001 and 19 November 2002 have been entered and considered.

Election/Restrictions

2. Applicant's election with traverse of Group I, claims 1-14 in the Response to Restriction Requirement filed 15 March 2005 is acknowledged. The traversal is on the ground(s) that Applicant believes that the groups of claims are so closely related that no additional searches are required. This is not found persuasive because, as specified by the Examiner in the Office Action of 15 February 2005 (Paper No. 02102005), the claims span inventions classified in two different classes and subclasses.

The requirement is still deemed proper and is therefore made FINAL.

3. Claims 15-34 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 02102005.

Art Unit: 3626

4. This application contains claims 15-34 drawn to an invention nonelected with traverse in the Response to Restriction Requirement filed 15 March 2005. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fraser, U.S. Patent Number 5, 664, 115 in view of Gindlesperger, U.S. Patent Number 6, 397, 197.

(A) As per claim 1, Fraser teaches a method of operating a computer system for the automatic selection of parties to an arrangement between a system-qualified requester of selected requirements and a system-qualified satisfier of specific requirements, the method comprising the steps of:

inputting into the computer system (Fraser; column 4, lines 35-54) a first predetermined composite of criteria representing each "buyer" (reads on "requester") qualified to enter the computer system as a system-qualified requester (Fraser; Figure 4B, column 4, lines 35-53, column 5, lines 47-53);

Art Unit: 3626

inputting into the computer system (Fraser; column 4, lines 35-54) a second predetermined composite of criteria representing each “seller” (reads on “satisfier”) qualified to serve as a system-qualified satisfier in the computer system (Fraser; Figure 4A, column 7, lines 19-36), the second predetermined composite of criteria including satisfaction criteria pertaining to the ability of the satisfier to satisfy specific requirements, and requesting criteria pertaining to requirements of the satisfier in a particular arrangement in order for the satisfier to enter into an arrangement with a particular requester (Fraser; Figure 6B, column 3, lines 7-20, 31-35);

entering into the computer system a request for a “seller” (reads on “satisfier”) by a “buyer” (reads on “requester”) identified as a system-qualified requester (Fraser; column 9, lines 2-7);

comparing in the computer system the schedule of requirements with the satisfaction criteria of the second predetermined composite of criteria to establish a selected group of system-qualified satisfiers able to meet the schedule of requirements (Fraser; Figure 5B, column 6, lines 59-67, column 9, lines 27-44);

inputting into the computer system a requester selected response and outputting from the computer system the requester selected response to notify the satisfier corresponding to the selected response of the selection of the selected response by the requester (Fraser; Figure 8B, Item S411, column 9, lines 20-43, column 10, lines 25-35); and

outputting from the computer system to the requester the identity of the satisfier and outputting from the computer system to the satisfier the identity of the requester for completion of the arrangement (Fraser; column 9, lines 20-43, column 10, lines 25-35).

Art Unit: 3626

Although Fraser teaches “the buyer can ... input a sorting criteria to select only preferred ones of the property listings (S107). For example, if searching for particular businesses being offered for sale, the prospective buyer specifies particular locations, ranges of sales volumes or SIC codes” (Fraser; column 6, lines 43-47), Fraser fails to explicitly disclose

the request for a satisfier including a schedule of requirements established by the system-qualified requester;

comparing in the computer system the requesting criteria of each satisfier of the selected group of system-qualified satisfiers with the first predetermined composite of criteria to establish a sub-group of satisfiers willing to enter into an arrangement with the system-qualified requester entering the request for a satisfier;

outputting from the computer system the request for a satisfier for submission to the sub-group of system-qualified satisfiers for timely responses by satisfiers of the sub-group of system-qualified satisfiers; and

inputting into the computer system timely responses by responding satisfiers of the sub-group of system-qualified satisfiers, and outputting from the computer system the timely responses inputted by the responding satisfiers for selection by the requester of a response from among those timely responses inputted by responding satisfiers.

However, the above features are well-known in the art, as evidenced by Gindlesperger.

In particular, Gindlesperger teaches

the request for a satisfier including an “RFQ” (reads on “schedule of requirements established by the system-qualified requester”) (Gindlesperger; column 1, lines 48-54);

Art Unit: 3626

comparing in the computer system the requesting criteria of each satisfier of the selected group of system-qualified satisfiers with the first predetermined composite of criteria to establish a sub-group of “vendors: (reads on “satisfiers”) willing to enter into an arrangement with the system-qualified requester entering the request for a satisfier (Gindlesperger; column 5, lines 10-27);

outputting from the computer system the request for a satisfier for submission to the sub-group of system-qualified satisfiers for timely responses by satisfiers of the sub-group of system-qualified satisfiers (Gindlesperger; Abstract, column 1, lines 48-54, column 5, lines 10-27, column 10, lines 27-29); and

inputting into the computer system timely responses by responding “vendors” (reads on “satisfiers” of the sub-group of system-qualified satisfiers, and outputting from the computer system the timely responses inputted by the responding satisfiers for selection by the requester of a response from among those timely responses inputted by responding satisfiers (Gindlesperger; Abstract, Figure 1, Item 22, column 1, lines 48-54, column 2, lines 1-7, column 5, lines 10-27, column 10, lines 27-29); Examiner interprets Gindlesperger’s teaching of “a given period of time” (Gindlesperger; column 2, lines 1-7) and “to comply with the required delivery date” (Gindlesperger; column 10, lines 27-29) as reading on Applicant’s recitation of “timely responses.”

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Fraser to include the request for a satisfier including a schedule of requirements established by the system-qualified “buyer” (reads on “requester”); and comparing in the computer system the requesting criteria of each satisfier of the selected

Art Unit: 3626

group of system-qualified satisfiers with the first predetermined composite of criteria to establish a sub-group of “vendors (reads on “satisfiers”) willing to enter into an arrangement with the system-qualified requester entering the request for a satisfier; and outputting from the computer system the request for a satisfier for submission to the sub-group of system-qualified satisfiers for timely responses by satisfiers of the sub-group of system-qualified satisfiers; and inputting into the computer system timely responses by responding satisfiers of the sub-group of system-qualified satisfiers, and outputting from the computer system the timely responses inputted by the responding satisfiers for selection by the requester of a response from among those timely responses inputted by responding satisfiers, as taught by Gindlesperger, with the motivations of providing “a system and method of competitive pricing for ...services that: (1) identifies and manages a large vendor pool to obtain the benefit of enhanced pricing competition, without imposing relatively high administrative costs or causing a loss of quality control; (2) offers vendors an inexpensive, cost effective and reliable system for obtaining access to ...[buyers]... without added marketing costs and sales commissions; and (3) does not rely on the vendors' product expertise to establish price, but rather allows each vendor to bid high, bid low, or not bid at all based, strictly, on their production capabilities and need to fill available time in their production schedules” (Gindlesperger; column 4, lines 38-51).

(B) Claim 8 differs from method claim 1, in that it is a system rather than a method for the automatic selection of parties to an arrangement between a system-qualified requester of selected requirements and a system-qualified satisfier of specific requirements.

System claim 8 recites the limitations of claim 1 as a series of elements features rather than a series of steps. As the method steps of claim 1 have been shown to be obvious in view of the collective teachings of Fraser and Gindlesperger in the above rejection of claim 1, it is readily apparent that the system disclosed by the applied prior art performs the recited underlying functions. As such, these limitations recited in claim 8 are rejected for the same reasons given above for method claim 1, and incorporated herein.

The motivations for combining the teachings of Fraser and Gindlesperger are as given in the rejection of claim 1 above, and incorporated herein.

7. Claims 2-3, 9-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fraser, U.S. Patent Number 5, 664, 115 in view of Gindlesperger, U.S. Patent Number 6, 397, 197 as applied to claim 1 above, and further in view of The Feedback Forum web pages, 1999. URL: <<http://web.archive.org/web/19990428182410/pages.ebay.com/aw/feedback.html>>.

(A) As per claims 2-3, Fraser and Gindlesperger teach a method as analyzed and discussed in claim 1 above.

Fraser and Gindlesperger fail to explicitly disclose a method further including inputting into the computer system, subsequent to completion of the arrangement, a rating by the requester of the performance of the satisfier, and including the rating in the satisfaction criteria of the second predetermined composite of criteria; and

Art Unit: 3626

inputting into the computer system, subsequent to completion of the arrangement, a rating by the satisfier of the performance of the requestor, and including the rating in the first predetermined composite of criteria.

However, the above features are well-known in the art, as evidenced by The Feedback Forum.

In particular, The Feedback Forum teaches

inputting into the computer system, subsequent to completion of the arrangement, a rating by the requester of the performance of the satisfier, and including the rating in the satisfaction criteria of the second predetermined composite of criteria (The Feedback Forum, page 1, paragraph 1-4, 10, page 8, paragraph 3); and

inputting into the computer system, subsequent to completion of the arrangement, a rating by the satisfier of the performance of the requestor, and including the rating in the first predetermined composite of criteria (The Feedback Forum, page 1, paragraph 1-4, 10, page 8, paragraph 3).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined teachings of Fraser and Gindlesperger to include inputting into the computer system, subsequent to completion of the arrangement, a rating by the requester of the performance of the satisfier, and including the rating in the satisfaction criteria of the second predetermined composite of criteria; and inputting into the computer system, subsequent to completion of the arrangement, a rating by the satisfier of the performance of the requestor, and including the rating in the first predetermined composite of criteria, as taught by The Feedback Forum, with the motivations of providing users with "important information that

Art Unit: 3626

makes trading on-line safe and more personal,” and that “gives you a good idea of what this person is like to do business with” (The Feedback Forum; page 1, paragraph 1, page 3, paragraph 3).

(B) As per claim 11, Fraser, Gindlesperger and The Feedback Forum teach an improvement in a method of operating a computer system for the automatic selection of parties to an arrangement to be completed between a system-qualified requester of selected requirements and a system-qualified satisfier of specific requirements, wherein a first predetermined composite of criteria representing each requester qualified to enter the computer system as a system-qualified requester is inputted into the computer system and a second predetermined composite of criteria representing each satisfier qualified to serve as a system-qualified satisfier in the computer system is inputted into the computer system, the second predetermined composite of criteria including satisfaction criteria pertaining to the ability of the satisfier to satisfy specific requirements, and requesting criteria pertaining to requirements of the satisfier in a particular arrangement in order for the satisfier to enter into an arrangement with a particular requester, the improvement comprising: inputting into the computer system, subsequent to completion of the arrangement, a rating by the requester of the performance of the satisfier, and including the rating in the satisfaction criteria of the second predetermined composite of criteria (The Feedback Forum, page 1, paragraph 1-4, 10, page 8, paragraph 3).

Examiner interprets claim 11 to be written in *Jepson* format, and therefore that the subject matter of the preamble is considered to be admitted prior art.

The motivations for combining the respective teachings of Fraser, Gindlesperger and The Feedback Forum are as given in the rejections of claims 1 and 2 above, and incorporated herein.

(C) As per claim 12, Fraser, Gindlesperger and The Feedback Forum teach an improvement in a method of operating a computer system for the automatic selection of parties to an arrangement to be completed between a system-qualified requester of selected requirements and a system-qualified satisfier of specific requirements, wherein a first predetermined composite of criteria representing each requester qualified to enter the computer system as a system-qualified requester is inputted into the computer system and a second predetermined composite of criteria representing each satisfier qualified to serve as a system-qualified satisfier in the computer system is inputted into the computer system, the improvement comprising: inputting into the computer system, subsequent to completion of the arrangement, a rating by the satisfier of the performance of the requester, and including the rating in the first predetermined composite of criteria (The Feedback Forum, page 1, paragraph 1-4, 10, page 8, paragraph 3)

Examiner interprets claim 12 to be written in *Jepson* format, and therefore that the subject matter of the preamble is considered to be admitted prior art.

The motivations for combining the respective teachings of Fraser, Gindlesperger and The Feedback Forum are as given in the rejections of claims 1 and 2 above, and incorporated herein.

(D) Claims 9-10, 13-14 differ from method claims 2-3, 11-12 in that they are drawn to a system or an improvement in a system rather than a method or an improvement in a method for the automatic selection of parties to an arrangement between a system-qualified requester of selected requirements and a system-qualified satisfier of specific requirements.

Art Unit: 3626

System claims 9-10, 13-14 recite the limitations of claims 2-3, 11-12 respectively as a series of elements features rather than a series of steps. As the method steps of claims 2-3, 11-12 have been shown to be obvious in view of the collective teachings of Fraser Gindlesperger and The Feedback Forum, it is readily apparent that the system disclosed by the applied prior art performs the recited underlying functions. As such, these limitations recited in claims 9-10, 13-14 are rejected for the same reasons given above for method claims 2-3, 11-12, and incorporated herein.

Examiner interprets claims 13-14 to be written in *Jepson* format, and therefore that the subject matter of their preambles is considered to be admitted prior art.

The motivations for combining the respective teachings of Fraser, Gindlesperger and The Feedback Forum are as given in the rejections of claims 1 and 2 above, and incorporated herein.

8. Claims 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fraser, U.S. Patent Number 5, 664, 115 in view of Gindlesperger, U.S. Patent Number 6, 397, 197 as applied to claim 1 above, and further in view of Breitfeld, P. et al., Pilot Study of a Point-of-use Decision Support Tool for Cancer Clinical Trials Eligibility. J Am Med Inform Assoc. 1999 Nov-Dec; 6(6): 466-477, URL: <<http://www.pubmedcentral.nih.gov/picrender.fcgi?artid=61390&blobtype=pdf>>, hereinafter known as Breitfeld.

(A) As per claims 4-5, Fraser and Gindlesperger teach a method as analyzed and discussed in claim 1 above.

Art Unit: 3626

Fraser and Gindlesperger fail to explicitly disclose a method further including wherein the arrangement comprises a clinical trial and

the requestor comprises a health-care provider, and the satisfier includes a candidate for potential participation in the clinical trial; and

the requestor comprises a pharmaceutical provider, and the satisfier includes a health-care provider.

However, the above features are well-known in the art, as evidenced by Breitfeld.

In particular, Breitfeld teaches a method further including wherein the arrangement comprises a clinical trial and

the requestor comprises a health-care provider, and the satisfier includes a candidate for potential participation in the clinical trial (Breitfeld; page 476, column 1, paragraph 1); and

the requestor comprises a pharmaceutical provider, and the satisfier includes a health-care provider (Breitfeld; page 476, column 2, paragraph 2 to page 477, column 1, paragraph 3);

Examiner interprets Breitfeld's teachings of "investigators designing new trials" (Breitfeld; page 476, column 2, paragraph 3) as teaching these limitations.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined teachings of Fraser and Gindlesperger to include xxx, as taught by Breitfeld, with the motivations of quickly pointing the user or requester to a limited number of protocols whose major eligibility requirements exactly match the characteristics of a particular patient and of matching clinical findings with varying eligibility criteria associated with multiple trials for which the patient might be eligible (Breitfeld; page 466, Abstract, page 467, paragraph 2).

Art Unit: 3626

(B) As per claims 6-7, Fraser, Gindlesperger and Breitfeld teach a method as analyzed and discussed above.

wherein the arrangement comprises the dissemination of information, the requester comprises an information provider, and the satisfier includes a party interested in receiving the information (Breitfeld; page 476, column 2, paragraph 2 to page 477, column 1, paragraph 3);

wherein the arrangement comprises the referral of a patient exhibiting particular symptoms, the requester includes a referring physician having observed the symptoms, and the satisfier includes a referred physician familiar with treatment of the symptoms (Breitfeld; page 467, column 2, paragraph 4).

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited but not applied references, Murphy et al., U.S. Patent Application Publication Number US 2001/0051882, Tozzoli et al, U.S. Patent Number 6, 151, 588, Raveis, Jr., U.S. Patent Number 6, 321, 202, Spiegelhoff et al, U.S. Patent Number 5, 742, 931, and Salmon et al, U.S. Patent Number 5, 592, 375 teach the environment of selecting participants in an arrangement.

10. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to: **(703) 305-7687.**

Art Unit: 3626

For informal or draft communications, please label
"PROPOSED" or "DRAFT" on the front page of the
communication and do NOT sign the communication.

After Final communications should be labeled "Box AF."

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (571) 272-6774. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.


12. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (571) 272-6776. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (571) 272-3600.

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Natalie A. Pass

May 31, 2005



JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600